

Remarks:

This application has been reviewed carefully in view of the Office Action mailed October 3, 2003 ("the Office Action"). In the Office Action, claim 1 was rejected under
5 35 U.S.C. § 102(b), as allegedly anticipated by Zunker, U.S. Patent No. 4,495,245.

The applicants note with appreciation that claim 2 was acknowledged to be allowable over the references of record. Please note that claim 2 has been amended to improve its grammatical structure without changing the claim scope, as discussed in a
10 telephone conversation with the examiner on January 29, 2004.

The above-described rejection is addressed as follows:

A) CLAIM 1 IS NOT ANTICIPATED UNDER § 102(b)

15 Claim 1 was rejected under 35 U.S.C. § 102(b), as allegedly anticipated by Zunker.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See*,
20 M.P.E.P. § 706.02.

Zunker discloses a composition comprising an inorganic filler which has its surface modified with vinyl alcohol polymer and with a cationic melamine-formaldehyde resin (see, col. 1, lines 51-54) to obtain a filler having adsorbed thereon from about 0.01 to
25 about 3%, based on dry filler weight, of each of vinyl alcohol polymer and cationic melamine-formaldehyde resin (see, col. 1, lines 44-47). Typical fillers include silicates, such as clay, talc, wollastonite, and precipitated calcium silicate; oxides, such as aluminum oxide, silica, and titanium dioxide; carbonates, such as precipitated and ground calcium carbonates; and sulfates, such as barium sulfate and calcium sulfate (Zunker, col. 2, lines
30 33-38). The amount of vinyl alcohol polymer adsorbed onto the filler can range from about 0.01% to 3%, based on dry filler weight, preferably from about 0.02 to about 2.5% (Zunker, col. 3, lines 50-53).

As described in Zunker, the following inorganic fillers were treated in 10% solids aqueous slurries with polyvinyl alcohol (PVA) or with a 1/1 (weight ratio) polyvinyl alcohol/cationic trimethylolmelamine acid colloid interaction product (PVA/TMM): hydrated clay, calcined clay, calcium carbonate ("Atomite", No. 9 "Whiting"), wollastonite ("NYAD"-G, "PMF") and silica ("HI-SIL"-215). At ambient temperature, 2.0 grams of filler was agitated in 18.0 grams total of water for thirty minutes after adding the surface treatment material in a portion of the water (Zunker, col. 4, line 67 - col. 5, line 8). The results show that the extent of adsorption of PVA onto fillers is enhanced when the PVA is added in conjunction with cationic TMM as a 1/1 interaction product (Zunker, col. 5, lines 51-53).

Claim 1 of the present application recites a treatment agent comprising silica particulates and polymer of vinyl alcohol series in the weight ratio in the range 30:70 to 70:30, whereas Zunker discloses a filler having adsorbed thereon from about 0.01 to about 3%, as mentioned above. For example, c11 and c12 of Zunker have 5.0 mg and 10.0 mg of PVA per 2 grams of filler (silica), which constitute 0.25% and 0.5%, respectively. The weight ratio of silica and polymer of vinyl alcohol series of the instant invention is not disclosed in Zunker. No higher amount of PVA per filler than 3% has been identified as disclosed or suggested by Zunker. Therefore, claim 1 recites one or more features not disclosed in Zunker.

Because the cited art fails to disclose, teach or suggest the features of independent claim 1, as highlighted above, the Office Action fails to establish a *prima facie* case of anticipation. Accordingly, the rejection of claim 1 under 35 U.S.C. § 102(b) is improper, and the applicants respectfully request it be withdrawn.

B) NEW CLAIMS

New claims 3-7 have been added to the application. No new matter has been added by the addition of these claims.

C) REQUEST FOR INTERVIEW

In light of the present amendments and remarks, the applicants believe that the claims are now in condition for allowance. Nevertheless, the applicants request a telephonic interview to try and efficiently resolve any claims that the examiner does not feel are in condition for allowance.

D) CONCLUSION

In view of the foregoing, the applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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